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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Jari HOVINEN et al.

Serial Number: 09/847,384

Group Art Unit: 1623

Filed: May 3, 2001

Examiner: Lewis, Patrick T.

For: OLIGONUCLEOTIDE LABELING REACTANTS AND THEIR USE

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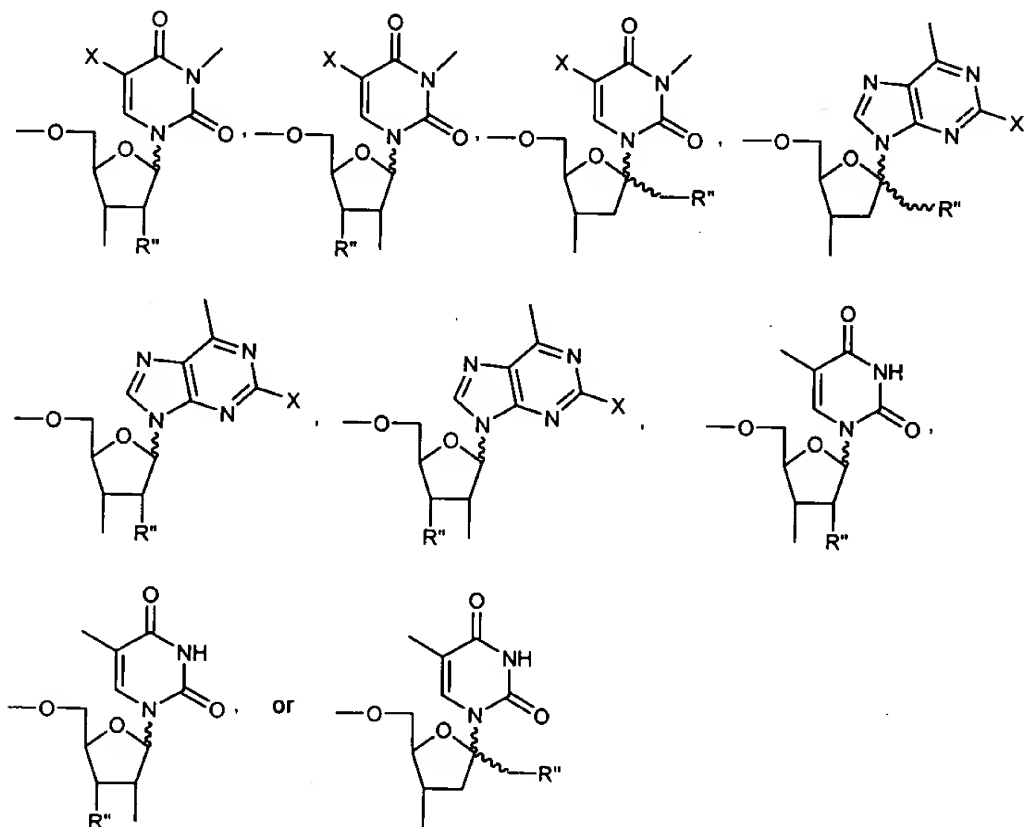
RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Washington, D.C. 20231

June 2, 2003

Sir:

In response to the Official Action mailed May 1, 2003, applicants provisionally elect, with traverse, Group IV, claims 1-11, drawn to a labeling reactant of formula (I) wherein Z is



The Restriction Requirement should be withdrawn because it improperly divides claim 1 into 6 different Groups. Such an improper restriction requirement violates the basic right of the applicant to claim his invention as he chooses, In re Weber, 580 F.2d 455, 198 USPQ 328 (Fed. Cir. 1978). In short, the Patent Office cannot refuse to examine a claim by imposing a restriction requirement:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim.

Id.

Reconsideration and withdrawal of the restriction requirement are earnestly requested.

In response to the Election of Species Requirement, Applicants provisionally elect compound 37, disclosed in Example 32 on page 35. Claims 1, 4, 5, 8, 10 and 11 read on the elected species.

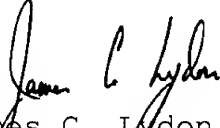
It is not believed any fee is required for entry and consideration of this Response. Nevertheless, the Commissioner is

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authorized to charge our Deposit Account No. 50-1258 in the amount  
of any such required fee.

Respectfully submitted,

  
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Enclosure:

In re Weber, 580 F.2d 455, 198 USPQ 328 (Fed. Cir. 1978)